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REMARKS / ARGUMENTS

Rejections under 35 U.S.C. §§ 102 and 103

The rejection of Claims 1, 2, and 4-8 have been maintained as anticipated by European Patent Application EP 1059372 A1 to Ochi et al. under 35 U.S.C. §102(b), as well as by U.S. Patent Application Publication 2003/0052436 A1 to Koyanagi et al ("Koyanagi") and U.S. Patent Application Publication 2002/0025433 A1 to Chang et al. ("Chang"). In the alternative, claims 1-8 have been rejected as unpatentable in view of any one of Ochi, Koyanagi, and Chang. Applicant respectfully traverses these rejections.

In addition to the Examiner's prior assertion that the MSSR was an inherent property of a bicomponent fiber as in Ochi, Koyanagi, and Chang, the Examiner has now asserted that a determination of the MSSR is inherent in these references. The Applicant points out that since it was not previously known that an MSSR existed, not only was a determination of MSSR not inherent in the cited references, but a determination of MSSR was, in fact, not performed.

Claim 1 includes a step for determining the maximum shrinkage spinning rate (MSSR) of the polymers to be combined in a bicomponent fiber. The Applicant has discovered that when preparing bicomponent fibers from polymers which differ in crystallization rates, a higher degree of latent shrinkage of the fiber may be achieved when the spinning speed varies only by $\pm 10\%$ from the MSSR. Determining the MSSR prior to spinning the fiber is essential to ensure maximization of the degree of latent shrinkage of the fiber.

It was not previously known that an MSSR existed. The present invention provides a method for preparing fiber such that the latent shrinkage of the fiber is maximized. The method is conducted by preparing the fiber at the MSSR, by first determining the MSSR which includes analyzing and considering several factors such

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as the ratio of crystallization rates of the two polymers, the absolute magnitude of the crystallization rate of the faster-to-crystallize component, the thickness or denier of the fiber being produced, the spinning temperature, and the type of quench imposed on the moving fiber line.

As previously stated, none of the cited references, Ochi, Koyanagi or Chang, disclose, teach or suggest that the latent shrinkage of the bicomponent fiber may be maximized by first determining the MSSR. Further, none of Ochi, Koyanagi or Chang discloses, teaches or suggests how the MSSR may be determined or what factors may be considered in the determination. Therefore, each of Ochi, Koyanagi, and Chang fails to either anticipate or render obvious the present claims.

In order for any reference to anticipate a claim, all elements of the claim must either be disclosed by or inherent in the reference. As mentioned above, the Examiner has asserted that the step of determining the MSSR was inherent in the references.

The standard of inherency is very clear. "Inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981). [citations omitted]. In other words, the element that is asserted to be inherent must necessarily and inevitably be present in the disclosure.

Applicant recognizes that the "mere recitation of a newly discovered function or property, inherently possessed by the things in the prior art, does not distinguish a claim drawn to those things from the prior art." *Id.* However, the present claims do not merely recite the newly discovered property, which is the existence of the MSSR. To the contrary, the present claims require the step of determining the MSSR and suitable methods of determining the MSSR are set forth in the examples.

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The step of determining the MSSR is new and would not have been obvious in view of the cited references considering that the existence of the MSSR was not previously known. That a step of determining an unknown property would have been inherent in a reference that does not disclose the property, *because the property was unknown*, does not logically follow. Therefore, it is clear that the step of determining the MSSR was not inherent in the cited references. As such, the cited references fail to anticipate the present invention and fail to establish a *prima facie* case of obviousness for failing to disclose every element of the present claims. Accordingly, reconsideration and withdrawal of the rejections under Sections 102 and 103, are appropriate and respectfully requested.

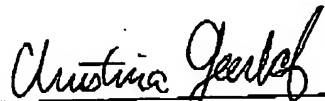
CONCLUSION

For the reasons stated above, claims 1-8 are believed to be in condition for allowance. Accordingly, Applicant respectfully requests that the Application be allowed. If prosecution may be further advanced, the Examiner is invited to telephone the undersigned to discuss this application.

It is not believed that any fees are required with the present response. However, if any fees are required, please charge or credit the balance to Deposit Account 50-3223.

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Respectfully submitted,



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